

REMARKS

In this Office Action, the Examiner once again rejected Claims 42-43 under 35 U.S.C. § 103(a) as being obvious, and therefore unpatentable, over a single patent document, namely Smith et al., U.S. Pat. No. 5,579,296 ("Smith") (*see* Office Action, Page 2, No. 1-2). Applicants respectfully disagree. The Applicants submit that the following arguments and amendments are made without prejudice as to patentability, including the doctrine of equivalents, and that no new matter has been added.

Applicants once again submit that independent Claim 42 and dependent Claim 43 are nonobvious over Smith, which Applicants disclosed in the parent application, and, furthermore, the Examiner has not set forth a proper *prima facie* case of obviousness as set forth by both the Federal Circuit and the MPEP. As noted in Applicants previous responses to establish a *prima facie* case of obviousness, three basic criteria must be met. *See In re Vaeck*, 979 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §§ 2142, 2143 – 2143.03.

Having previously discussed the basic premises set forth by the Federal Circuit and CCPA regarding the suggestion or motivation to modify or combine, and after reviewing the Examiner's Final Office Action, with respect to Claims 42-43, Applicants still believe that the crux of the misunderstanding between the Applicants and the Examiner relates to why it would be obvious to one skilled in the art to use a method of forming a compact disc that teaches away from the method of forming a compact disc disclosed in Applicants' patent application.

As discussed previously Smith is primarily directed at "provid[ing] a thin film digital data storage medium which can be duplicated at high speed by specialized microembossing techniques involving the use of a master embossing drum including a series of laterally spaced apart microembossing shims or masters permitting the simultaneous reproduction of multiple copies of a single microembossed master onto a web of low cost thin film material." (Smith Col. 1:41-48). Additionally, Smith teaches the use of a thin film system to mass produce compact discs, and

Because adaptor 30 also serves the function of centering the thin film system relative to CD playback hardware and provides an area having a planar surface for receiving and maintaining the thin film system in a flat configuration aligned with the relevant CD player geometry, the actual perimeter configuration of the thin film system or its "shape" is relatively unimportant. For example, as illustrated in FIG. 29, the perimeter of a thin film product 10 may be configured as a circle, a

square, a rectangle, a triangle, a star, an animal head or in any of a virtually limitless variety of different geometric shapes. For advertising and promotional applications, such shape flexibility represents a significant benefit.

(Smith Col. 9:66 to 10:10)(emphasis added).

Applicants' invention, in contrast, is for a method of "injection molding" a disc "having a major elevational portion bounded by first and second pairs of spaced-apart outer side peripheries defining outer boundaries of at least portions of the disc, each of the first pair of spaced-apart peripheries arcuately extending between each of the second pair of spaced-apart outer side peripheries, and each of the second pair of spaced-apart outer side peripheries extending substantially linearly between each of the first pairs of spaced-apart outer peripheries." (Application, Amended Claim 42). Clearly the shape of the product produced using Applicants' method is important, while the shape is irrelevant under Smith that teaches the use of a thin film system for the creation of non-circular shaped compact discs where "the actual perimeter configuration of the thin film system or its 'shape' is relatively unimportant." (Smith Col. 10:3-5)(emphasis added). Furthermore, Smith does not even suggest the shape disclosed in Applicants' claimed method. The teachings Smith regarding the use of a thin film system to produce a non-circular disc in combination with the teaching away from using a molding process, (*see, e.g.*, Smith Col. 1:34-37, 5:10-16, and 9:34-40), would not lead a person of ordinary skill in the art to replicate Applicants' claimed method which involves molding to form a certain non-circular shape. Furthermore, Applicants would once again observe that Applicants use the word "mold" to describe:

a method of forming a trading card optical compact disc according to the present invention preferably includes molding at least one plastic rectangular layer having a width of about 2.5 inches and a length of about 3.5 inches and having a pattern of digital data encoded thereon. Prior to this molding step, however, and as understood by those skilled in the art, data for the disc is optically, e.g., preferably by laser techniques, mastered from data files or other software programs. The master is then electroplated with a metal material, e.g., silver and prepped for replicating positive mold copies or shims. Die stampers are produced from the electroplated shims. The plastic layer is then formed by injection molding from a negative image on the die stamper.

(Published Application, Page 4, para. 38).

Thus unlike Smith, which uses a thin film system, Applicants disclose a method of layering or injection molding the non-functional portion of the disc to the major elevational layer including the digitally encoded information. In essence, Smith is aimed at a using a thin film system to manufacture compact discs of any shape, and Applicants' method is aimed at a molding process for a certain defined shape. Therefore, while both Applicants and Smith produce a non-round disc, the methods of achieving the results are not compatible, and one skilled in the art would not readily make a leap of faith without some additional suggestion or motivation to produce a non-round disc by an injection molding process. Furthermore, the Examiner has not identified or even hinted at where such a suggestion or motivation to add use an injection molding process for the shape claimed by Applicants is found in Smith or any other source.

Please note, in commenting upon the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions or making any amendments herein to create any implied limitations in the claims. Not all of the distinctions between the cited documents and Applicants' present invention have been made by Applicants. For the foregoing reasons, Applicants reserve the right to submit additional evidence showing the distinctions between Applicants' invention to be novel and nonobvious in view of the cited documents.

The foregoing remarks are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facets of the invention that render it patentable, being only examples of certain advantageous features and differences.

CONCLUSION

In view of the amendments and remarks without prejudice set forth herein, Applicants respectfully submits that the application is in condition for allowance. Accordingly, the issuance of a Notice of Allowance in due course is respectfully requested.

Dated: December 19, 2006

BRACEWELL & GIULIANI LLP
P.O. Box 61389
Houston, Texas 77208-1389
Telephone: (713) 221-1185
Facsimile: (713) 221-2141
Email: jeffrey.whittle@bgllp.com

Respectfully submitted,



Jeffrey S. Whittle
Reg. No. 36,382